

REMARKS

Included herein is a request for a one-month extension of time along with the appropriate fee.

In the Office Action mailed 11/5/2004, Claims 1-15 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b). Claims 1-15 were further provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

In response, Applicant has amended claims 1, 5, 9 and 12 in view of the prior art, as discussed below. Applicant has further added new Claim 16 – 18; no new matter has been entered.

With respect to the rejection of Claims 1-15 under the judicially created doctrine of obviousness-type double patenting, Applicant requests clarification. The Examiner indicates that the rejection is “in view of Gibson,” but does not indicate what the statutory grounds for the rejections are (i.e. it appears that 35 U.S.C. §103 has been relied upon, but it is not clear that this is the ground for rejection of these claims). Applicant respectfully requests clarification on this point.

Anticipation under 35 U.S.C. §102(a)

Claims 1-15 were rejected as being anticipated by Gibson et al., U.S. Patent No. 4,367,877. Applicant respectfully traverses this rejection because Gibson fails to disclose each and every limitation of the amended claims in accordance with 35 U.S.C. §102.

Specifically, Gibson fails to recite or otherwise disclose at least the following limitations:

03/03/2005 BROWNER 00000011 10000710

01 FC:2251

60.00 0P

-5/9-

1. "spaced relation" positioning between an elongate bar and a projection surface (claim 1);
2. a "void" beneath an elongate bar and a projection surface (claim 9); or
3. an "elongate bar shape" having "opposing ends extending from said golf club head" (claim 12).

Furthermore, the undersigned has reviewed the other references cited by the Examiner (McCabe, Benson, and DiMartino), and determined that none of the aforementioned limitations to the amended independent claims is recited or otherwise disclosed by any of these other references. Applicant provides this to assist in the rapid examination of this application, even though the Examiner has not specifically relied upon these references in rejection Applicant's claims.

Since each and every limitation of Applicant's independent claims 1, 9 and 12 are not disclosed by the cited references, the Examiner has not cited

1. a single reference¹
2. that teaches or enables²
3. each of the claimed elements (arranged as in the claim)³
4. expressly or inherently⁴
5. as interpreted by one of ordinary skill in the art.⁵

, therefore a prima facie case of anticipation has not been made, and this ground for rejection must be withdrawn.

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

⁴ *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

Obviousness Rejections

As discussed above, it is unclear from the Office Action whether §103 is the grounds for rejection of Claims 1-15 in the OA discussion commencing at page 4. As for the obviousness-type double patenting, Applicant herein submits a properly worded terminal disclaimer along with the appropriate fee and this (provisional) ground for rejection is overcome.

Regarding the possible future rejection of these claims as being obvious over Gibson, McCabe, Benson, and DiMartino, none of these references, either alone or in combination disclose the specific structure claimed by Applicant in his amended claims. It is Applicant's position that the structural distinctions recited in his claims are extremely important to the functionality, durability and aesthetic desirability of his device. As such, the solid head of Gibson, the "extension" of McCabe being anchored only on a single side, the lack of a "void" in Benson, and the lack of an "elongate bar-shaped" dome in DiMartino are, in Applicant's opinion, non-functional alternates to Applicant's claimed design. In view of the density of the field of invention, the specific choice away from Applicant's claimed design is a clear indication that the art teaches away from Applicant's claimed design.

Since the cited references fail to teach a suggestion to combine or modify the references in a way that would make Applicant's design obvious, the Examiner has failed to prove a *prima facie* case of obviousness, namely:

1. one or more references⁶

⁵ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

⁶ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

2. that were available to the inventor⁷
3. where the reference(s) teach⁸
4. a suggestion to combine or modify the reference(s)⁹
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.¹⁰

, and therefore this ground for rejection should not be imposed by the Examiner in a future Office Action, and the claims should therefore be allowed.

⁷ See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

⁸ *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

⁹ *In re Lalu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

¹⁰ *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

STEINS & ASSOCIATES

Karl M. Steins
Registration No. 40,186
2333 Camino del Rio South
Suite 120
San Diego, California 92108
Telephone: (619) 692-2004
Facsimile: (619) 692-2003